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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/735,597	12/12/2003	Avelino Corma Canos	2429-1-028	1746

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KLAUBER & JACKSON
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EXAMINER

NGUYEN, CAM N

ART UNIT	PAPER NUMBER
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1793

MAIL DATE	DELIVERY MODE
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03/20/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/735,597	Applicant(s) CORMA CANOS ET AL.	
	Examiner Cam N. Nguyen	Art Unit 1793	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12/20/07 (and 11/16/07)- an election.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) 15 and 16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 May 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>01/26/04 & 03/02/05</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Election/Restrictions

1. Applicant's election with traverse of Group I, claims 1-14, in the reply filed on 12/20/08 (and 11/16/07) is acknowledged. The traversal is on the ground(s) that "a search of the catalyst itself must be thorough and necessarily involves searching uses of the same. Applicants submit that it cannot represent a serious burden to concurrently search processes for treating waters using the catalyst while searching the very catalyst itself." (applicants' response on page 6 of the amendment filed on 11/16/07). This is not found persuasive because the search required for Group I is not required for Group II. Thus, if both groups are searched, an additional burden is imposed on the Office due to two different search areas being required. Furthermore, the process of Group II requires specific process steps and conditions to treat waters and eliminate nitrates present in the liquid phase in the waters; which the catalyst claims of Group I do not require. Also, it has been held that the patentability of the product and process are separately determined, therefore, for purposes of search and examination on the merits, the claims must be restricted. However, in accordance with the MPEP rule, the process claims can be rejoined with the elected product claims once they are found allowable.

The requirement is still deemed proper and is therefore made FINAL.

2. Claims 15-16 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention(s), there being no allowable generic or linking claim.

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Applicant timely traversed the restriction (election) requirement in the reply filed on 12/20/07 (and 11/16/07).

Claim Objections

3. Claims 1, 3-4, 6-7, & 12-13 are objected to because of the following informalities:
- A. In claim 1, line 2, "and" (first occurrence) should be deleted and replaced thereof with -- , --.
- B. In claim 1, line 2, -- , -- should be inserted before "and" (second occurrence).
- C. In claim 1, last line, "aluminium" should be changed to recite --aluminum--.
- D. In claim 3, "line 2, "among" should be deleted and replaced thereof with --the group consisting of--.
- E. In claim 4, line 2-3, "referring to the total weight of the catalyst" should be deleted.
- F. In claim 4, line 3, --, based on the total weight of the catalyst--- should be inserted after "weight" (second occurrence at the end of the claim).
- G. In claim 6, line 2, "among Cu, Sn, ... Fe or Co" should be changed to recite --the group consisting of Cu, Sn, ... Fe and Co--.
- H. In claim 7, line 2-3, "referring to the total weight of the catalyst" should be deleted.
- I. In claim 7, line 3, --, based on the total weight of the catalyst--- should be inserted after "weight" (at the end of the claim).
- J. In claim 12, line 2, "aluminium" should be changed to recite --aluminum--.
- K. In claim 13, line 2, "is" should be changed to recite --are--.

Appropriate correction is required.

Claim Rejections - 35 USC § 112 (First Paragraph)

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-14 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The instant claim 1 recites the support composition having a formula XYMgAl, wherein X is at least one noble metal; Y is at least one non-noble metal; Mg is magnesium; and Al is aluminum. However, according to applicants' specification on page 10-12, Examples 1, 2, & 3, all three catalysts were prepared by impregnating or supporting the Pd and Cu metals on the magnesium-aluminum compound (or hydrotalcite). Even though Example 3 shows Cu was added during the preparation of the hydrotalcite, it does not include the Pd (or component X) during the preparation of the support composition. Thus, there is no basis or support for the claimed support composition containing X (which is at least one noble metal) and Y (which is at least one non-noble) components in the instant claims.

Claim Rejections - 35 USC § 102(b)

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-8 are rejected under 35 U.S.C. 102(b) as being anticipated by Elliot et al., "hereinafter referred to as Elliot '645", (US Pat. 5,039,645).

Elliot '645 discloses a solid composition of matter which comprises a mixture of (1) a hardened hydraulic cement and (2) a catalyst composition comprising (a) an inorganic support material, (b) at least one of platinum and palladium metal, and (c) at least one iron component selected from the group consisting of iron oxide, iron metal and mixtures thereof (see col. 6, claim 1). Component (a) of said catalyst composition is selected from the group consisting of alumina, magnesia, magnesium aluminate, hydrotalcite, silica, titania, zirconia, vanadia and mixtures thereof (see col. 6- col. 7, claim 4). The catalyst composition comprises 0.05-10 weight % Pt and about 0.1-15 weight % Fe (see col. 8, claim 14). See also entire reference for further details.

There is no patentable distinction seen between the claimed catalyst and that disclosed by Elliot '645. Thus, the claims are anticipated by the teaching of the reference.

Claim Rejections - 35 USC § 102(b)/103

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 9-14 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Elliot et al., "hereinafter referred to as Elliot '645", (US Pat. 5,039,645).

Product-by-process limitations in the claims are noted. While the disclosed product is not made by the same process, including conditions such as temperature, etc., the catalyst composition disclosed is the same as being claimed. It has been held that the patentability of the product and its method of production are separately determined. Thus, even though the process limitations in the claims are not disregarded, they have no bearing on the patentability of the claims product per se. See *In re Thorpe*, 227 USPQ 964 (Fed. Cir. 1985); *In re Brown*, 173 USPQ 688, 688 (CCPA 1977); *In re Fessman*, 180 USPQ 324, 326 (CCPA 1977). See also *MPEP 2113*.

Citations

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. All references are cited for related art. See PTO-892 Form prepared attached.

Conclusion

8. Claims 1-16 are pending. Claims 1-14 are rejected. Claims 15-16 are withdrawn due to nonelected (distinct) invention(s). No claims are allowed.

Contacts

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Primary Examiner Cam N Nguyen, whose telephone number is 571-272-1357. The examiner can normally be reached on M-F, 9:00 AM - 6:30 PM, at alternative work site.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stanley Silverman, can be reached on 571-272-1358. The fax phone number for the organization where this application or proceeding is assigned is 571-272-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Cam N. Nguyen/

Primary Examiner

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/C. N. N./

Primary Examiner, Art Unit 1793

March 16, 2008